

REMARKS

Claims 16 and 23-33 have been canceled. Thus, Claims 10, 14-15, 17-18 and 21-22 are pending in the present application, each of which has been amended. No new matter has been added. Reconsideration and withdrawal of the rejections in view of the comments presented herein are respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 10, 14-15, 17-18 and 21-22 were rejected rejection under 35 U.S.C. § 112, second paragraph based on recitation of a "system" which allegedly does not clearly set forth the statutory category to which the invention belongs. Although Applicant does not agree with the rejection, the claims have been amended to recite a "combination" instead of a "system." The amended claims clearly relate to a combination of "manufactures" within the statutory classes of inventions set forth in 35 U.S.C. § 101.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Claim Interpretation

The Office Action asserts that recitation of "a printable substrate...wherein the printable substrate carries a complementary reactant" relates the apparatus to contents thereof during an intended operation, and are of no significance in determining patentability of an apparatus claim. Therefore the printable substrate which comprises the complimentary reactant was not considered as a limitation to the present claims.

Although Applicant believes that this recitation was already, in fact, limiting to the claim, and not an intended use, Claim 10 has been amended to recite "[a] liquid toner digital press and printable substrate combination comprising..." Therefore, it is now clear that the printable substrate (which carries the complimentary reactant) is a positive limitation of the claims.

Rejection under 35 U.S.C. § 102(b)

Claim 10 was rejected under 35 U.S.C. § 102(b) as allegedly being unpatentable over Dukler (WO 00/78556).

Because the Examiner did not consider the printable substrate comprising the complimentary reactant to be a patentable limitation to claim 10, this claim was rejected as being anticipated by Dukler et al. since only the liquid toner/security feature components were

considered. However, since Claim 10 as amended clearly positively recites the printable substrate, it must be regarded as a patentable limitation to the claim.

Dukler discloses a fluorescent ink which results in an invisible image that can only be seen upon illumination with UV light. This image is not created by reaction with a substrate containing a complementary reactant as recited in the present claims. Thus, Dukler neither discloses nor suggests the combination of a reactant and complementary reactant to form an invisible security feature that is retained in or on the substrate in the event of fraudulent alteration or removal of the toner image as recited in present claim 10. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Rejection under 35 U.S.C. 103(a)

Claims 16, 23-30 and 33 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Dukler (WO 00/78556) in view of Nagashima (US 4,148,968), and 3 and 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over the same combination of references, and further in view of Yanaka (US 2003/0068575).

Claims 16, 23-30 and 33 have been canceled, thus rendering the rejection under 35 U.S.C. § 103 moot.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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